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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/359,809 | 07/23/1999 | RICHARD LEVY | 01064.0011-0 | 3299 |
| 7590 | 05/24/2006 | | EXAMINER | |
| LAW OFFICES OF ROBERT J. EICHELBURG HODAFEL BUILDING, SUITE 200 196 ACTON ROAD ANNAPOLIS, MD 21403 | | | TOOMER, CEPHIA D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1714 | |

DATE MAILED: 05/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/359,809 | LEVY, RICHARD |
| | Examiner | Art Unit |
| | Cephia D. Toomer | 1714 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 9/2/05.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 73-100 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 73-100 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

This Office action is in response to the amendment filed September 2, 2005 in which claims 73, 76, 77, 80-83 and 90 were amended. The 112, first paragraph rejection with respect to claims 73 and 76 is withdrawn in view of Applicant's arguments. The 112, second paragraph rejection is withdrawn in view of the amendment to the claims and Applicant's arguments. The 102 rejection is withdrawn in view of the amendment to the claims. The 103 rejection over Martineu is withdrawn in view of Applicant's arguments.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 73-100 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 85-110 of copending Application No. 10/781,240. Although the conflicting claims are not identical, they are not patentably distinct from each other because the lubricant composition of

the present invention is the same composition used in the method of lubricating a surface. Therefore, it would be reasonable to expect that the lubricant composition of the present invention would be used to lubricate a surface.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 73-100 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 90-115 of copending Application No. 10/763,687. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present invention are encompassed by the lubricant composition of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 73-100 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 57-90 of copending Application No. 10/614,114. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the present claims do not contain a substrate, it would be reasonable to expect that the lubricant composition would be applied to substrate such as in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 89 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 89 is rejected because the specification does not support a substantially anhydrous composition.

Applicant argues that at page 29, second paragraph support is found for a substantially anhydrous composition. The examiner respectfully disagrees. That the composition may have the consistency of a grease is not adequate support for a substantially anhydrous composition.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 73, 74, 76, 77 and 90 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Takayama (US 5,792,717).

Takayama teaches a sliding material comprising a porous ceramic body that has open pores filled with a high water absorbing resin (see abstract). The ceramic body may be boron nitride and the resin may be crosslinked polyacrylates (see col. 4, lines 4-11; col. 5, lines 16-28). The resin absorbs at least 100 times its weight in water (see col. 4, lines 60-67). Takayama teaches that the composition has lubricity properties (see col. 4, lines 30-43).

Takayama fails to teach that the boron nitride remains in particulate form. However, Takayama does teach that he starts out with BN particles that are 10 micrometer or less and that these particles are shaped into ceramic bodies. The ceramic bodies in combination with the superabsorbent polymers still function as a lubricating material.

9. Claims 73-76, 80-82, 86, 87, 89-93, 96, 99 and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US 5,275,760) in view of Obayashi (US 4,340,706).

Johnson teaches a gelled corrosion inhibitor comprising a gelling agent slurried in a first medium and a corrosion inhibitor dissolved in a second liquid medium, wherein the gelling agent forms a gel in the second liquid medium (see abstract; col. 3, lines 3-7). The gelling agents are water insoluble hydrogel-forming materials known in the art as superabsorbent polymers (see col. 3, lines 21-23, 31-68). The gelling agents are carried as a slurry in an oil such as fatty esters, mineral oils and lubricating oils (first

Art Unit: 1714

medium). The corrosion inhibitor (lubricant additive) is dissolved in water (see col. 4, lines 39-55). The corrosion inhibitor may be alkali or alkaline earth metal carbonate (applicant's carbonate) (see col. 4, lines 44048). Johnson teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, Johnson differs from the claims in that he does not specifically teach applicant's intended use. However, intended use is given no patentable weight in claims that are directed to the composition per se.

In the second aspect, Johnson differs from the claims in that he does not specifically teach that the super absorbent polymer absorbs greater than 100 times its weight in water. However, Obayashi teaches this difference. Obayashi teaches that the cross-linked neutralized polyacrylic acid taught by Johnson absorbs at least 400-800 times its weight in water (see abstract; col. 6, lines 42-66).

It would have been obvious to one of ordinary skill in the art to use the claimed polymers because Johnson teaches the use of superabsorbent polymers and Obayashi teaches that these polymers absorb greater than 100 times their weight in water.

In the third aspect, Johnson differs from the claims in that he does not specifically teach that the oils are polymerized olefins. However, no unobviousness is seen in this difference because Johnson teaches that hydrocarbon oils may be used in the invention and this broad teaching suggests polymerized olefins, which are hydrocarbon oils.

Response to Arguments

10. Applicant's arguments have been fully considered but they are not persuasive.

Art Unit: 1714

11. Applicant argues that the boron nitride of Takayama is monolithic boron nitride whereas the boron nitride of the present invention is particulate boron nitride.

The ceramic bodies of Takayama in combination with the superabsorbent polymers still function as a lubricating material. Applicant has not shown that the use of particulate boron nitride produces unexpected results.

12. Applicant argues that the composition of Takayama does not have lubricity properties.

Takayama teaches that the sliding material of his invention has self-lubricating properties (see col. 1, lines 21-27; col. 2, lines 54-61).

13. Applicant argues that Johnson does not teach the claimed invention because he describes the use of oils with the polymers. Applicant argues that these compounds bear no chemical resemblance to the inorganic materials of claim 73 or the materials of subset (2).

The examiner respectfully disagrees. Johnson teaches a second liquid medium comprising carbonates of alkali or alkaline earth metals (see col. 4, lines 39-49). These compounds read on the claimed lubricating metal carbonate.

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 1714

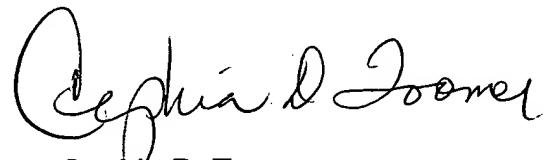
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cephia D. Toomer
Primary Examiner
Art Unit 1714

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